UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,994	08/09/2000	Howard Dernehl	DERN-00101	5407

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EXAMINER
ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
06/15/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr>
<td rowspan="2">Advisory Action
Before the Filing of an Appeal Brief</td>
<td>Application No.
09/635,994</td>
<td>Applicant(s)
DERNEHL ET AL.</td>
</tr>
<tr>
<td>Examiner
Raquel Alvarez</td>
<td>Art Unit
3688</td>
</tr>
</table>

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>04 June 2010</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Continuation of 11. does NOT place the application in condition for allowance because:With respect to Applicant's arguments pertaining to point 7, Applicant argues that the Examiner has failed to address, in any way, Applicant's arguments of why it is not obvious to a person of ordinary skill in the art to personalize the referral with the UPC. The Examiner disagrees with Applicant because as stated on the Final dated 4/14/2010 it would have been obvious to personalize each phone with the well known process of assigning an UPC code to items in order to uniquely identify each of the phones being recommended.

    With respect to Applicant's arguments pertaining to point 8, Applicant argues that the Examiner has failed to address, in any way, Applicant's arguments pertaining to correlating the first e-mail message to data within the database. The Examiner has explained in the rejection mailed on 4/14/2010 how Recommend-it.com teaches the first user will send an e-mail to a friend or colleague detailing the site and would include a short description identifying advertisements)(page 2); correlating the first set of data in the first e-mail message to data within a database (page 2); updating the database with an e-mail address of a second party provided by the first party (pages 1-4); forwarding the first e-mail message to the e-mail address of the second party (see page 4). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the invention of Argos Business Solutions the teachings of recommend-it.com of sending the recommendation via an e-mail message to the second party comprising a personalized referral for the marketable entity including an URL link to the web site of the service provider and updating the database with the e-mail address of the second party because such a modification would allow the second party the convenience of using his or her computer to viewed all the details of the items recommended.

    With respect to Applicant's arguments pertaining to points 9 and 12, Applicant argues that Recommend-it doesn't teach that the e-mail addresses provided by the user are stored in the database. As stated on the Final rejection mailed on 4/14/2010, the email is saved in a variable or temporary basis, the e-mail address is saved in some sort of storage or database. Since the claims do not specify if the e-mail address is saved on a temporary or permanent basis, the rejection is sustained. Applicant further argues that it would not have been obvious in Recommend-it to have saved because according to Applicant Recommend-it simply informs visitors of a site and there is no reason to save the e-mail addresses permanently since the visitors need not later be referenced for any purpose. The Examiner disagrees with Applicant because in Recommend-it the visitors receive e-mails about the software WedDeck and therefore it would have been obvious for Recommend-it to save the e-mail addresses of the party recommended in order to send additional e-mails about other promotions and the like.

    Applicant argues that Recommend-it doesn't teach a from field populated with an e-mail address of the first party, The Examiner disagrees with Applicant because in Recommend-it, the e-mail received by the second party includes the e-mail address of the recommender. Applicant further argues that although the email address of the recommender is shown, it is not shown in the reply-to field, not the from field. The Examiner wants to point out that the claims only call for a from field populated with the e-mail of the first party and in recommend-it, Eileen velet@didem.com represents the starting point or where the recommendation came from.

    Applicant argues that the references do not teach authenticating e-mail messages. The Examiner wants to point out that in Recommend-it the first user provides the e-mail messages of the referees to Recommend-it which will forward an e-mail messages to the second parties, third parties on behalf of the first party, the e-mail addressed would have to be the e-mail addresses would have to authenticated by the system in order for the e-mail to be sent for example, at the point where Recommend-it construct the e-mail messages to the second, third parties, the e-mail addresses correctness is confirmed in order for the e-mail to be transmitted. If an incorrect e-mail was submitted for a particular party then the party will not be able to receive the message because of the incorrect e-mail address. In addition, Applicant argues that authentication is not by the first party. The Examiner wants to point out that the e-mail although not directly form the first party is indirectly from the first party since the first party is the recommender of the second party to the system.

    In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one skilled in the art given the Argos reference would be able to combine it with Recommend-it to provide the electronic means of implementing the incentive scheme using electronic means in order to provide accessibility and convenient to the incentive scheme of Argos. The reasoning to combine the reference need not only be found in the reference but can also be from knowledge generally available to one of ordinary skill in the art so as is in this case (see case laws above). In addition Argos teaches a database of merchandises and points (paragraph 3) so therefore Argos is not totally silent as to the use of electronic means.

    With respect to Applicant's arguments pertaining to updating the database with an e-mail address of the second party. The Examiner wants to point out that in Recommend-it service constructs a personalized e-mail message to the second party that was recommended by the first party in order for Recommend-it to send the message to the second party, the e-mail addresses must be stored somewhere in order to enable Recommend-it to retrieve and use of the e-mail address provided. Just because Recommend-it doesn't sell or transfer e-mail addresses to third parties, it doesn't mean that they don't store the e-mail addressed in their databases.